

***REMARKS*****Claim Rejections under 35 U.S.C. § 101**

Claim 24 is rejected under 35 U.S.C. § 101 because the claimed invention is allegedly directed to non-statutory subject matter. The Examiner stated that the use of a composition is not patentable. Applicant amends herein claim 24 to a method claim. Applicant submits that claim 24 is now allowable for at least this reason.

**Claim Rejections under 35 U.S.C. § 112**

Claims 5 and 8 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for allegedly failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Office asserts that claims 5 and 8 contain improper Markush language. Applicant respectfully traverses, and directs the Office's attention to the Manual of Patent Examining Procedure (MPEP) §2173.05 (h), which states:

Alternative expressions are permitted if they present no uncertainty or ambiguity with respect to the question of scope or clarity of the claims. *One acceptable form of alternative expression...* is commonly referred to as a Markush group.... When materials recited in a claim are so related as to constitute a proper Markush group, they may be recited in the conventional manner, *or alternatively*. For example, if "wherein R is a material selected from the group consisting of A, B, C and D" is a proper limitation, then "wherein R is A, B, C or D" shall also be considered proper.

(Emphasis added.) Thus, while a Markush group is one acceptable expression in claim language, Applicant is not limited to that exact expression, and may use alternative expressions as long as the claim language and scope are certain and unambiguous. Applicant believes that an exemplary phrase "X selected from A, B, and C" is clear and unambiguous. Similarly, an exemplary phrase "X is at least one of A, B, and C" is likewise clear and unambiguous. Applicant is not limited to the exact phrasing so long as the claims as they stand are clear and unambiguous. Because they fall into the categories of the exemplary phrases given, the claims are also clear and unambiguous. Thus, Applicant respectfully requests that the rejection of claims 5 and 8 be withdrawn.

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Claim Rejections under 35 U.S.C. §102

(a) Claims 1-8, 10, and 16-21 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,173,531 to Kissel, U.S. Patent No. 5,375,636 to Dresdner, Jr., U.S. Patent No. 5,728,781 to Usuki *et al.*, or U.S. Patent No. 6,063,849 to Morris *et al.* Applicant respectfully traverses the rejection of the claims based on each of the references.

(1) Kissel

The Office Action states that "Kissel discloses a dried polymer/salt product comprising colloidal salt particulates in claims 1 and 3, metals in claim 13 and zinc acetate in Table A. The coated textile is a formed article." *Page 3*. Applicant respectfully traverses.

Amended claim 1 recites the following: "A composition for coating or forming a medical device or coating a medicament, the composition comprising:... wherein the composition is designed for at least one of the following uses: formation of a medical device, a coating on the medical device, and a coating on the medicament." (Emphasis added). *Kissel* does not teach or suggest at least these features. Instead, the entire disclosure of *Kissel* is directed to "the field of textile materials, to antistatic materials, to a composition useful for providing antistatic properties to textiles...." *Col. 1, lines 14-17*. Therefore, the passages of *Kissel* that are used by the Office to reject the instant claim 1 are also directed to "the method comprising the step of contacting a textile material with a product admixture composition...." (claims 1 and 13) and "[a] dry compounded polymer/salt product composition providing a textile material with an antistatic property" (claim 3). Therefore it is not taught by, nor obvious from, *Kissel*, to take its composition used for treating a textile material to provide antistatic properties of the textile materials to arrive at the compositions for coating or forming a medical device or coating a medicament, as recited in claim 1.

Therefore, Applicant respectfully requests that the rejection of claim 1 be withdrawn. Because claim 1 is allowable, for at least this reason, its dependent claims 2-24 are also allowable as a matter of law. *See Minnesota Mining and Mfg. Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002). Additionally and notwithstanding the foregoing reasons for the allowability of claim 1, its dependent claims recite further features and/or combinations of features

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(as is apparent by examination of the claims themselves) that are patentably distinct from the prior art of record. Hence, there are other reasons why these dependent claims are allowable.

(2) Dresdner

The Office Action states that "Dresdner, Jr. teaches a glove containing colloidal silver iodide in gelatin in claim 5 and polymers in claim 3. For manufacturing process see Example 1." Page 3. Applicant respectfully traverses.

Amended claim 1 recites the following: "A composition for coating or forming a medical device or coating a medicament, the composition comprising:... wherein the composition is designed for at least one of the following uses: the formation of the medical device, the coating on the medical device, and the coating on the medicament." (Emphasis added). *Dresdner* does not teach or suggest at least these features. Instead, the entire disclosure of *Dresdner* is directed to "a ... medical glove.... In particular the present invention is a glove containing an antiseptic composition other than a liquid antiseptic composition within the glove wall...." *Col. 1, lines 6-12*. Indeed, the polymer of *Dresdner* that are used by the Office to reject the instant claim 1 are also directed to a material on the glove wall. See *Dresdner* at claims 1 and 3. These are not polymers that are used in a composition in conjunction with a colloid, as recited in claim 1. Instead, the colloid of claim 5 of *Dresdner* is used in an antiseptic composition that is disposed between the glove walls. It is not taught by, nor obvious from, *Dresdner* to combine a polymer and "a colloid comprising a salt or oxide of one or more oligodynamic metals" in a "composition for coating or forming a medical device or coating a medicament," as recited in claim 1.

Therefore, Applicant respectfully requests that the rejection of claim 1 be withdrawn. Because claim 1 is allowable, for at least this reason, its dependent claims 2-24 are also allowable as a matter of law. Applicant also requests the withdrawal of the rejection of claims 2-24 for at least this reason. There may be other reasons as well for the allowability of dependent claims 2-24.

(4) Usuki

The Office Action states that "Usuki et al. recite colloidal salts and oxides in claim 12 and polyalkylene oxides in claim 1." *Page 3*. Applicant respectfully traverses.

Amended claim 1 recites the following: "a colloid comprising a salt or oxide of one or more oligodynamic metals;... wherein the composition is designed for at least one of the following uses: formation of a medical device, a coating on the medical device, and a coating on the medicament." (Emphasis added). *Usuki* does not teach or suggest at least these features. Instead, the entire disclosure of *Usuki* "relates to a novel polymer scale deposition preventive agent and... to provide a preventive agent capable of effectively preventing polymer scale deposition not only in polymerizing vinyl chloride but also in polymerizing the other monomer having an ethylenically unsaturated double bond, which as a high solvency power, such as  $\alpha$ -methylstyrene; and to a process for producing a polymer using said agent." *Col. 1, lines 62-col. 2, 2*. In addition, *Usuki* teaches that "[a]ccording to the present invention, polymer scale can be effectively prevented from being deposited on areas, with which the monomer having an ethylenically unsaturated double bond is brought into contact, such as the inner wall surface of a polymerization vessel and a stirrer." *Col. 2, lines 20-24*. Therefore, *Usuki* does not teach or suggest a composition for forming a medical device, a coating on the medical device, or a coating on the medicament, as recited in claim 1.

In addition, the passages of *Usuki* that are used by the Office to reject the instant claim 1, namely claims 1 and 12, do not teach or suggest the feature of an "a colloid comprising a salt or oxide of one or more oligodynamic metals," as recited in claim 1. According to the specification, "[t]he term 'oligodynamic agents' refers to any compound that can provide antimicrobial activity, even when present in small quantities." *Published Application* at paragraph 0055, lines 4-7. Nothing in *Usuki* teaches or suggests any compound that can provide antimicrobial activity. Instead, as noted above, the compounds of *Usuki* are directed to preventing polymer scale deposition. Therefore, all of the features of independent claim 1 are not taught by, nor obvious from, *Usuki*.

Therefore, Applicant respectfully requests that the rejection of claim 1 be withdrawn. Because claim 1 is allowable, for at least this reason, its dependent claims 2-24 are also allowable as a matter of law.

(b) Claims 1-11 and 14-14 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,596,401 to Terry *et al.*, U.S. Patent No. 6,605,751 to Gibbins *et al.*, U.S. Patent No. 6,756,124 to Kanamori *et al.*, or U.S. Publication No. 2003/0007985 to Chevalier *et al.*

(1) Terry et al.

Applicant submits herewith an Affidavit under 37 C.F.R. 132 that asserts that the Applicant is a co-inventor of the *Terry et al.* reference and that the inventions disclosed but not claimed in the *Terry et al.* reference were invented by the Applicant. Therefore, Applicant has obviated the rejection based on *Terry et al.* Applicant respectfully requests that the rejection be withdrawn.

(2) Gibbins et al.

Certain passages of *Gibbins* that are used by the Office to reject the instant claim 1, for example claims 1, 17, 19, 21, and 25, are only disclosed in the *Gibbins* reference, and not its earlier-filed parent applications. The earliest effective filing date of the present application precedes the *Gibbins* reference. Even though *Gibbins* is a continuation-in-part and claims priority to a patent filed before the instant application, not all of the passages relied on by the Office are disclosed in the parent application.

The MPEP states as follows:

IV. Filing Date of U.S. Parent Application Can Only Be Used as the 35 U.S.C. 102(e) Date If It Supports the Claims of the Issued Child:

In order to carry back the 35 U.S.C. 102(e) critical date of the U.S. patent reference to the filing date of a parent application, the U.S. patent reference must have a right of priority to the earlier date under 35 U.S.C. 120 or 365(c) and the parent application must support the invention claimed as required by 35 U.S.C. 112, first paragraph.

§ 2136.03 (Emphasis added). The MPEP then gives the following example:

The examiner made a 35 U.S.C. 103 rejection over a U.S. patent to Pfluger. The Pfluger patent (Pfluger IV) was the child of a string of abandoned parent applications (Pfluger I, the first application, Pfluger II and III, both CIPs). Pfluger IV was a continuation of Pfluger III. The court characterized the contents of the applications as follows: Pfluger I - subject matter A, II-AB, III-ABC, IV-ABC. ABC anticipated the claims of the examined application, but the filing date of III

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was later than the application filing date. So the examiner reached back to "A" in Pfluger I and combined this disclosure with another reference to establish obviousness. *The court held that the examiner impermissibly carried over "A" and should have instead determined which of the parent applications contained the subject matter which made Pfluger patentable. Only if B and C were not claimed, or at least not critical to the patentability of Pfluger IV, could the filing date of Pfluger I be used.* The court reversed the rejection based on a determination that Pfluger IV was only entitled to the Pfluger III filing date. The added new matter (C) was critical to the claims of the issued patent.

(citing *In re Wertheim*, 646 F.2d 527, 537, 209 USPQ 554, 564 (CCPA 1981) (emphasis added)).

Similarly, here the Applicant's parent application, U.S. Application Serial No. 09/461,846, filed on December 15, 1999, contains subject matter that supports the subject matter of independent claim 1. Therefore, Applicant is entitled to an effective filing date of December 15, 1999 with respect to claim 1. The *Gibbins* reference, however, was filed on September 29, 2000, after the earliest effective filing date of the parent application.

Although the *Gibbins* reference is a continuation-in-part of U.S. Pat. No. 6,355,858 ("the *Gibbins* parent"), which is a continuation-in-part of U.S. Pat. No. 5,928,174 ("the *Gibbins* grandparent"), it is impermissible for the Office to rely on these references. Applicant's representative has made a careful study of the *Gibbins* parent and the *Gibbins* grandparent, and does not find support for all of the claimed subject matter of *Gibbins* in the two prior-filed application. In particular, the subject matter of claims 1, 17, 19, 21, and 25 of *Gibbins*, relied on by the Office in rejecting independent claim 1, is not supported under 35 USC §112, first paragraph by either the *Gibbins* parent or the *Gibbins* grandparent.

Therefore, *Gibbins* cannot be relied on to support a rejection of the claims of the instant application. Applicant therefore respectfully requests that the rejection be withdrawn.

(3) Kanamori et al.

Applicant's earliest effective filing date (December 15, 1999) precedes the filing date of *Kanamori* (April 13, 2001). According to MPEP §706.02(b), a rejection under 35 USC 102(c) can be overcome by (1) perfecting priority under 35 USC 120 to a prior application that precedes the filing date of the cited reference, and (2) establishing that the prior application satisfies the enablement and written description requirements of 35 U.S.C. 112, first paragraph. In the instant application, the Applicant has perfected its claim of priority under 35 USC 102(e) by submitting

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a Preliminary Amendment on February 4, 2004 that amended the first paragraph of the specification of the application to claim priority to U.S. patent application serial number 09/461,846, filed December 15, 1999 (which is now U.S. Patent No. 6,716,895 ('895 Patent)).

The '895 Patent satisfies the enablement and written description requirements of 35 U.S.C. 112, first paragraph, by providing support for independent claim 1 that have been rejected based on the *Kanamori* reference in at least the following passages of the patent: col. 6, line 14 - col. 7, line 62, col. 8, lines 6-59, and col. 14, line 20 - col. 15, line 20. Applicant has now fulfilled both of the requirements for overcoming a reference cited under 35 USC 102(e), and respectfully request that the rejection of the claims based on the *Kanamori* reference be withdrawn.

(4) Chevalier et al.

Applicant's earliest effective filing date (December 15, 1999) precedes the filing date of *Chevalier* (April 13, 2001). According to MPEP §706.02(b), a rejection under 35 USC 102(e) can be overcome by (1) perfecting priority under 35 USC 120 to a prior application that precedes the filing date of the cited reference, and (2) establishing that the prior application satisfies the enablement and written description requirements of 35 U.S.C. 112, first paragraph. In the instant application, the Applicant has perfected its claim of priority under 35 USC 102(e) by submitting a Preliminary Amendment on February 4, 2004 that amended the first paragraph of the specification of the application to claim priority to U.S. patent application serial number 09/461,846, filed December 15, 1999 (which is now U.S. Patent No. 6,716,895 ('895 Patent)).

The '895 Patent satisfies the enablement and written description requirements of 35 U.S.C. 112, first paragraph, by providing support for independent claim 1 that have been rejected based on the *Chevalier* reference in at least the following passages of the patent: col. 6, line 14 - col. 7, line 62, col. 8, lines 6-59, and col. 14, line 20 - col. 15, line 20. Applicant has now fulfilled both of the requirements for overcoming a reference cited under 35 USC 102(e), and respectfully requests that the rejection of the claims based on the *Chevalier* reference be withdrawn.

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Att Unit: 1714Claim Rejections under 35 U.S.C. § 103

Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Kissel, Dresdner, Jr., Usuki et al., Morris et al, Terry et al., Gibbins et al., Kanamori et al., or Chevalier et al.* Applicant respectfully traverses each of the rejections. The rejections based on each of these references have been obviated for the reasons stated above.

Double Patenting Rejection

Claims 1-8 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 41, 43-52, and 56-58 of copending Application Ser. No. 10/212,505. Applicant acknowledges the provisional double patenting rejection and will respond to the rejection upon an indication of allowability of the present claims 1-8, thereby deferring payment of the statutory fee for a terminal disclaimer.

Newly Added Claims

Claims 25-37 has been newly added to further define and/or clarify the scope of the claims.

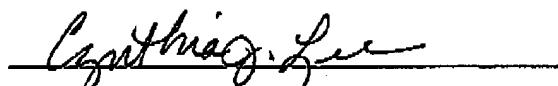
New claims 34-37 are allowable over the prior art of record for at least the reason that they depend upon independent claims 10, 17, 18, and 19, respectively, each of which depends from claim 1, which is also allowable as noted above.

Applicant believes that no new matter has been added and that a new search is not required to examine the newly added claims. Therefore, for at least this and other reasons, Applicant respectfully requests that newly added claims 25-37 be allowed.

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Art Unit: 1714**CONCLUSION**

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 1-37 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephone conference would expedite the examination of this matter, the Examiner is invited to call the undersigned agent at (770) 933-9500.

Respectfully submitted,

  
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